REMARKS

Priority

A certified priority document is not required if applicants are not relying on the use of the priority document to overcome prior art rejections, which is the case in the present case.

Specification

Applicants thank the Examiner for pointing out the preferred arrangement of the specification, but because the guidelines pointed to are not requirement, but merely suggestions, applicants respectfully decline to amend the specification.

Election/Restriction

The allegation that the claims were not free of prior art is incorrect for the reasons discussed below in detail. Thus, the examination should not have terminated at the defined scope in the Office Action.

The Rejections Under 35 USC § 112

Applicants respectfully disagree with the rejection, but to advance this application to an expeditious allowance, cancelled the rejected matter without prejudice or disclaimer.

The First Rejections Under 35 USC § 102

Claims 1-15, 20-21, 23 and 25-29 are rejected as allegedly anticipated b y Dorsch, WO '099, US '858. This rejection is erroneous.

Please note the definition of R^1 in **independent claim 1** defined as A and requiring that it "is mono-, di- or trisubstituted by $S(=O)(=NR^2)R^2$, $NR^2SO_2R^2$, OSO_2R^2, $OSO_2N(R^2)_2$ or $PO(OR^2)_2$."

The corresponding R^1 group (the broadest disclosure thereof) is Dorsch is "H, Ar, Het, cycloalkyl or A, which may be substituted by OR_2, SR_2, $N(R_2)_2$, Ar, Het, cycloalkyl, CN, $COOR_2$ or $CON(R_2)_2$." R^2 therein (the broadest disclosure thereof) is "H or A," and A therein (the broadest disclosure thereof) is "unbranched or branched alkyl having 1-10 carbon atoms, in which one or two CH_2 groups may be replaced by O or S atoms and/or by -CH=CH- groups and/or in addition 1-7 H atoms may be replaced by F."

The required substituents on R^1 of the claims of the present application are not taught

or even suggested by Dorsch. There is not even a generic overlap as none of the required substituents can even be constructed out of the broadest disclosure in the general formula of Dorsch.

Also, none of the cited allegedly anticipating compounds are within the scope of the present claims for at least the reason that no compound in Dorsch contains a required substituent of R^1 of claim 1 or any of its dependent claims of the present application.

Please note the definition of R^1 in **independent claim 26** defined as A and requiring that it "is mono-, di- or trisubstituted by $SO_2N(R^{2'})_2$, $SO_3R^{2'}$, $S(=O)(=NR^{2'})R^2$, $NR^2SO_2R^2$, OSO_2R^2, $OSO_2N(R^2)_2$ or $PO(OR^2)_2$."

The corresponding R^1 group (the broadest disclosure thereof) is Dorsch is "H, Ar, Het, cycloalkyl or A, which may be substituted by OR_2, SR_2, $N(R_2)_2$, Ar, Het, cycloalkyl, CN, $COOR_2$ or $CON(R_2)_2$." R^2 therein (the broadest disclosure thereof) is "H or A," and A therein (the broadest disclosure thereof) is "unbranched or branched alkyl having 1-10 carbon atoms, in which one or two CH_2 groups may be replaced by O or S atoms and/or by -CH=CH- groups and/or in addition 1-7 H atoms may be replaced by F."

The required substituents on R^1 of the claims of the present application are not taught or even suggested by Dorsch. There is not even a generic overlap as none of the required substituents can even be constructed out of the broadest disclosure in the general formula of Dorsch.

Also, none of the cited allegedly anticipating compounds are within the scope of the present claims for at least the reason that no compound in Dorsch contains a required substituent of R^1 of claim 26 or any of its dependent claims of the present application.

Please note the definition of R^1 in **independent claim 28** defined as A and requiring that it "is mono-, di- or trisubstituted by $S(O)_mR^2$, $SO_2N(R^2)_2$, SO_3R^2, $S(=O)(=NR^2)R^2$, $NR^2SO_2R^2$, OSO_2R^2, $OSO_2N(R^2)_2$ or $PO(OR^2)_2$." In claim 28, m is defined as "1 or 2."

The corresponding R^1 group (the broadest disclosure thereof) is Dorsch is "H, Ar, Het, cycloalkyl or A, which may be substituted by OR_2, SR_2, $N(R_2)_2$, Ar, Het, cycloalkyl, CN, $COOR_2$ or $CON(R_2)_2$." R^2 therein (the broadest disclosure thereof) is "H or A," and A therein (the broadest disclosure thereof) is "unbranched or branched alkyl having 1-10 carbon atoms, in which one or two CH_2 groups may be replaced by O or S atoms and/or by -CH=CH- groups and/or in addition 1-7 H atoms may be replaced by F."

The required substituents on R^1 of the claims of the present application are not taught or even suggested by Dorsch. There is not even a generic overlap as none of the required substituents can even be constructed out of the broadest disclosure in the general formula of Dorsch.

Also, none of the cited allegedly anticipating compounds are within the scope of the present claims for at least the reason that no compound in Dorsch contains a required substituent of R^1 of claim 28 or any of its dependent claims of the present application.

The Second Rejections Under 35 USC § 102 and

The Obviousness-Type Double Patenting Rejection

Claims 1-15, 20-21, 23 and 25-29 are rejected as allegedly anticipated by Dorsch, WO '235, US '277, and claims 1-15, 20-21 and 23 as allegedly unpatentable under obviousness-type double patenting over claims 1-18, 23-24 and 26 of US '277. These rejections are also erroneous.

Please note the definition of R^1 in **independent claim 1** defined as A and requiring that it "is mono-, di- or trisubstituted by $S(=O)(=NR^2)R^2$, $NR^2SO_2R^2$, OSO_2R^2, $OSO_2N(R^2)_2$ or $PO(OR^2)_2$."

The corresponding R^1 group (the broadest disclosure thereof) is Dorsch is "H, Ar, Het, cycloalkyl or A, which may be substituted by OR_2, $S(O)_mR^2$, $N(R_2)_2$, Ar, Het, cycloalkyl, CN, $COOR_2$ or $CON(R_2)_2$." R^2 therein (the broadest disclosure thereof) is "H, A, $-[C(R^3)_2]_n$-Ar, $-[C(R^3)_2]_n$-Het, $-[C(R^3)_2]_n$-cycloalkyl, $-[C(R^3)_2]_n-N(R^3)_2$ or $-[C(R^3)_2]_n-OR^3$," and m and n (the broadest disclosures thereof) are both independently defined as "0, 1 or 2."

The required substituents on R^1 of claim 1 of the present application are not taught or even suggested by Dorsch. There is not even a generic overlap as none of the required substituents can even be constructed out of the broadest disclosure in the general formula of Dorsch.

None of the cited compounds are within the scope of the present claims for at least the reason that no compound in Dorsch contains a required substituent of R^1 of claim 1 of the present application.

Please also note the definition of R^1 in **independent claim 26** defined as A and requiring that it "is mono-, di- or trisubstituted by $SO_2N(R^{2'})_2$, $SO_3R^{2'}$, $S(=O)(=NR^{2'})R^2$,

$NR^2SO_2R^2$, OSO_2R^2, $OSO_2N(R^2)_2$ or $PO(OR^2)_2$." $R^{2'}$ in claim 26 denotes "-$[C(R^3)_2]_n$-Ar', -$[C(R^3)_2]_n$-Het', -$[C(R^3)_2]_n$-cycloalkyl, -$[C(R^3)_2]_n$-$N(R^3)_2$ or -$[C(R^3)_2]_n$-OR^3."

The corresponding R^1 group (the broadest disclosure thereof) is Dorsch is "H, Ar, Het, cycloalkyl or A, which may be substituted by OR_2, $S(O)_mR^2$, $N(R_2)_2$, Ar, Het, cycloalkyl, CN, $COOR_2$ or $CON(R_2)_2$." R^2 therein (the broadest disclosure thereof) is "H, A, -$[C(R^3)_2]_n$-Ar, -$[C(R^3)_2]_n$-Het, -$[C(R^3)_2]_n$-cycloalkyl, -$[C(R^3)_2]_n$-$N(R^3)_2$ or -$[C(R^3)_2]_n$-OR^3," R^3 therein (the broadest disclosure thereof) is "H or A," and m and n (the broadest disclosures thereof) are both independently defined as "0, 1 or 2."

The required substituents on R^1 of claim 1 of the present application are not taught or even suggested by Dorsch. There is not even a generic overlap as none of the required substituents can even be constructed out of the broadest disclosure in the general formula of Dorsch.

None of the cited compounds are within the scope of the present claims for at least the reason that no compound in Dorsch contains a required substituent of R^1 of claim 26 of the present application.

Please note the definition of T in **independent claim 28** defined as requiring an oxo substituent when a ring moiety, i.e., "denotes a mono- or bicyclic saturated, unsaturated or aromatic carbo- or heterocycle having 0 to 4 N, O and/or S atoms, which is mono-, di- or trisubstituted by =O, and which in addition may be mono-, di- or trisubstituted by …"

The corresponding T group (the broadest disclosure thereof) is Dorsch is "T is a monocyclic or bicyclic saturated, unsaturated or aromatic carbocyclic or heterocyclic ring having from 1 to 4 N, O and/or S atoms, which is monosubstituted or disubstituted by =S, $=NR_2$, $=NOR_2$, $=NCOR_2$, $=NCOOR_2$, $=NOCOR_2$, =N-CN or $=N-NO_2$ and may furthermore be monosubstituted, disubstituted or trisubstituted by Hal, A, -$[C(R^3)_2]_n$-Ar, -$[C(R^3)_2]_n$-Het, -$[C(R^3)_2]_n$-cycloalkyl, OR^3, $N(R^3)_2$, NO_2, CN, $COOR^2$, $CON(R)_2$, NR^2COA, $NR^2CON(R^2)_2$, NR^2SO_2A, COR^2, SO_2NR^2 and/or $S(O)_mA$."

The required oxo substituent on T of claim 28 of the present application is not taught or even suggested by Dorsch. There is not even a generic overlap as the required substituent cannot even be constructed out of the broadest disclosure in the general formula of Dorsch.

None of the cited compounds are within the scope of the present claims for at least the reason that no compound in Dorsch contains a required substituent of T of claim 28 of the present application.

Withdrawn Claims

Additionally, applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder, which states that "if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined." Accordingly, rejoinder and examination of the withdrawn claims is respectfully and courteously requested at the proper time in accord with the rejoinder provisions of the MPEP.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

Csaba Henter, Reg. No. 50,908
Attorney for Applicants

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Boulevard, Suite 1400
Arlington, VA 22201
Telephone: 703-243-6333
Facsimile: 703-243-6410
Attorney Docket No.:MERCK-3039

Date: March 27, 2009